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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
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WASHINGTON, DC 20006-1109

EXAMINER

DAGNEW, SABA

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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03/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,250

Applicant(s)

SOREM, STEVE

Examiner

SABA DAGNEW

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

/Raquel Alvarez/

Primary Examiner, Art Unit 3688 DETAILED ACTION

Status of Claims

This action is in reply to the amendment filed on 12 December 2008. Claims 1-4, 6-7, 9, 13-33, 36-43, 45-49, 51-60, and 62-69 have been amended. Claims 1-69 are currently pending and have been examined.

Claim Objections

The claims 1, 25, 44, 50, 59, 60 and 61 are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17, 24-25, 28-38, 44-50, 54-63, and 65-69 rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (U.S. Patent No. 6,138,106)

With respect to claims 1, 25, 44, 50 and 59-61 Walker teaches a method for tracking promotion at least one group products, a remote station for tracking valuation, a system, and method of at least one of a group of products, each of which bears a code that uniquely identifies each product in the group, method comprises:

communicatively coupling a remote station to a user station (**Fig. 1, and Col. 4, lines 1-12**, where “personal computer” reads on user station and “central controller 2” reads on a remote station);

providing a database at the remote station (**Fig. 2, teaches four databases 26-32 Fig. 3 and Col. 4, lines 23-27**, where “central controller 2” connected to “storage device” reads on database);

storing in the database ones of the uniquely identifying codes that have been previously received from one or more user stations (**Fig. 4, where “item code” reads on uniquely identifying code and Col. 2, lines 40-67, which teaches processor receiving data identifying the first product code**);

comparing each new candidate code received from a given user station against the previously received codes stored in the database (**Col. 3, lines 1-15, and Col. 11, 11-29, which teaches matching the value of the gift certificate (product) code with the product selected**);

crediting an account of a user associated with the given user station with a non-zero promotional credit only if such new candidate code received from the given user station was not previously stored in the database (**Col. 2, lines 53-59, where “adjusting**

credit value" reads on crediting an account of a user, Col. 3, lines 1-15, which teaches "reduce the initial value" reads on non-zero promotional credit and Col. 11, lines 17-22, where "returning the change to the buyer via credit card" reads on crediting an account of user) ; and

storing such new candidate code in the database as a previously received code if such new candidate code was not previously stored in the database (**Fig. 5, 70B**, e.g. teaches "code number 6C1076223, stored after the value credited to user account" and **Col. 11, lines 30-47**, which teaches maintaining the gift certificate code).

With respect to claim 2, Walker teaches all elements of claim 1, furthermore, Walker teaches the method wherein said database further includes at least one permissible new candidate code (**Fig. 2, 28**, which teaches gift certificate code database and **Fig. 5**, code number 72, allowable candidate code), and

wherein the at least one permissible new candidate code may be provided by a provider of the ones in the group (**Fig. 7A, 128 and Col. 6, lines 23-34**, where teaches "merchant been established gift items" candidate code may be provided by provider **Col. 6, lines 65-67**, where "a gift code central controller 12" reads on provider provided a gift code and **Col. 7, lines 1-5**), and

wherein said database server compares each new candidate code against the at least one permissible new candidate code (**Col. 11, lines 35-47**, which teaches examine to identify records)

With respect to claims 3 Walker teaches all elements of claims 1 and 2, furthermore, Walker teaches the method wherein the non-zero valuation credit may be not credited if the new candidate code doesn't match one of the at least one permissible new candidate codes (**Fig. 7A, 140**, which teaches credit card code doesn't match, it passes an error message such as "invalid account")

With respect to claims 4, and 9, Walker teaches all elements of claims 1 and 3, furthermore, Walker teaches the method wherein there are at least two groups, and wherein each group may be provided by a different provider (**Fig. 5, 82**, multiple seller ID number shows that there are more than provider) .

With respect to claims 5, and 10 Walker teaches all elements of claims 1, 2, 3, 4 and 9, furthermore, Walker teaches the method wherein said database server maintains separate previously received codes and separate permissible new candidate codes for each provider (**Fig. 2, and Col. 4, lines 23-35**, which teaches maintaining a separate database).

With respect to claims 6 and 32, Walker teaches all elements of claims 1 and 25, furthermore, Walker teaches the method wherein said database may be resident on a network server at the remote station (**Fig. 2, and Col. 4, lines 23-43**, which teaches storage device 22, contain for databases) .

With respect to claims 7, 33, 62 and 63, Walker teaches all elements of claims 1, 6, 25, 32 and 61, furthermore, Walker teaches the method, wherein the communicative

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coupling may be an internet connection (**Col. 4, lines 1-5, which teaches connecting via internet**).

With respect to claim 8, Walker teaches all elements of claim 1; furthermore, Walker teaches the method wherein said database server includes one account associated with each user to correspond to one group for the crediting of the non-zero valuation credit (**Col. 11, lines 18-26, where "direct refund" reads on crediting non-zero valuation credit**)

With respect to claims 11, 34, 46 and 55, Walker teaches all elements of claims 1, 25, 44 and 50, furthermore, Walker teaches the method wherein said database server, upon storing a previously received code, further stores the previously received code as a consumed code (**Fig. 5 and Col. 5, lines 48-55, which teaches gift certificate "filled/redeemed" reads on consumed**)

With respect to claims 12, 35, 47 and 56 Walker teaches all elements of claims 1, 11, 25, 34, 44, 46, 50 and 55, furthermore, Walker teaches the method wherein the consumed code cannot be entered as a previously received code by a subsequent user (**Col. 8, lines 56-62, which teaches cancelling as expired**).

With respect to claims 13-17, and 36-38 Walker teaches all elements of claims 1 and 25 Walker teaches a method wherein the uniquely identifying code may be a UPC, SPIF, numeric, alphabetic and alpha-numeric (**Fig. 4, 62, where "item code" reads on unique code, which is numeric Fig. 5, 72, where teaches alpha-numeric code**) .

With respect to claim 24, Walker teaches all element of claim 1, furthermore, Walker teaches the method wherein a credit certificate may be issued to the user account once a pre set value of non-zero valuation credits may be accumulated in the user account (**Col. 8, lines 56-64**, where “redeemer/user submit accumulated initial code value” reads on non-zero valuation credit may be accumulated).

With respect to claims 28, 48 and 57, Walker teaches all elements of claim 25, 44 and 50, furthermore, Walker teaches the method wherein said database further includes at least one permissible new candidate code, and wherein the at least one permissible new candidate code may be provided by a provider of the certificates in the group (**Col. 8, lines 8-19**, which teaches gift certificate code generated and mailed to customer by the credit card issuer) and wherein said database server compares each new candidate code against the at least one permissible new candidate code (**Col. 8, lines 12-19**, which teaches direction are provided, where customer to contact to activate the code, and the controller compares and issue authorization).

With respect to claim 29, Walker addressed by the rejection of claim 3 as cited above.

With respect to claim 30-31, Walker addressed by the rejection of claims 4 and 5 as cited above.

With respect to claims 45 and 54 Walker teaches all elements of claims 44 and 50, furthermore, teaches Walker the method of further comprising receiving at the

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remote station from the user station the new candidate code prior to said comparing
(Col. 3, lines 4-8, which teaches receiving data identifying product code).

With respect to claim 49, Walker addressed by the rejection of claim 3 as cited above.

With respect to claim 58, Walker addressed by the rejection of claims 1 and 2 as cited above.

With respect to claim 65, Walker teaches all elements of claim 61, furthermore, Walker teaches the method wherein said at least one back-end service includes at least one of a server and software resource **(Col. 4, lines 1-22, where “buyer/redeemer interface” reads on software and Col. 4, lines 37-43, teaches “control programs and Certificate redemption program” reads on software and server is inherent)** and consumer account **(Col. 5, lines 4-8, which teach account established).**

With respect to claim 66-69, Walker teaches all elements of claim 61, furthermore, Walker teaches wherein transactions include value based transactions, interacting includes debit, credit **(Col. 4, line 67, and Col. 5, 1-3, which teaches debit and credit transaction)** and value chaining **(Col. 11, lines 19-20, which teaches direct refund)**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-22, 26-27, 39-42, 51-53 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,138,106)

With respect to claim 18, Walker teaches all elements of claim 1, except new candidate code may be placed under a peel off label. However, the examiner takes an official notice that it's old and well known in the art to place a product code under peel off label to remove the label from the product easily. For example, peeling off the piece of paper affixed from the product. Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invention to add a peel of label feature in order to remove the code from the product.

With respect to claims 19-22 and 39-42, Walker teaches all elements of claims 1 and 25, including a user input device such as a keyboard to type the new candidate code into an internet browser (**Col. 4, lines 1- 5**), but Walker does not explicitly teaches a code reader. However, the examiner takes an official notice that it's old and well known in the art that to have code reader for tracking asset and inventory. Therefore, it would have been obvious to the one ordinary skill in the art at the time of invention to add code reader feature in order to minimize cost.

With respect to claims 26, 51 and 64, Walker teaches all elements of claims 25, , 50, 61 and 62 including buyer is a register user (**Col. 6, lines 39-40**) , but Walker does not explicitly teaches that the user may be a retailer. Therefore, official notice taken it

is well known in the art at the time the invention was made to add seller of the certificate as a customer of the product of the manufacturer because a seller of the gift certificate is allowing its customer to buy a manufacture's product to generate higher revenue and to give flexible process for the redeemer.

With respect to claims 27, Walker teaches all elements of claim 25 and 26, furthermore, Walker teaches the method, wherein the account credited may be a retailer's account, and wherein the non-zero certificate credit may be equivalent to a purchase value for the certificate (**Col. 5, line 1-3, which teaches "a card number stored in being debited for at purchase for a pre-paid certificate)**

With respect to claim 52, Walker teaches all elements of claims 50 and 51, furthermore, Walker teaches the method further comprising exchanging, by the retailer, of at least one product of value equivalent to the gift certificate for the gift certificate, prior to said comparing (**Fig. 5, 70D, which teaches initial value is equal to remaining code value and Col. 2, lines 34-39, where "selecting a gift within a value of the certificate" reads on product value equivalent to the gift certificate)**

With respect to claim 53, Walker addressed by the rejection of claim 27 as cited above.

Claims 23, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,138,106) in view of Dodd (U.S. Patent No. 6, 321, 211).

With respect to claims 23 and 43, Walker teaches all elements of claims 1 and 25, including redeeming and receiving a gift certificate codes via internet (**Col. 8, lines**

39-46). However, Walker does not teach the method wherein a web browser may be resident on the remote station and the user station.

Dodd teaches the method wherein a web browser may be resident on the remote station and the user station (**Col. 3, lines 28-36, which teaches user/gift giver uses browser to select online gift for the recipient**). Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invitation was made to add Todd's browser software feature to Walker's dynamic gift selection and redeeming feature in order to click when the hyperlink contacted with the gift server (**Todd, Col. 11, lines 24-25**)

Response to Arguments

Applicant's arguments filed 12 December 2008 have been fully considered but they are not persuasive.

Applicant argued in page 13 that Walker fails to indicate where the processor receives the data from and it fails to disclose the memory stores the first product. However, the Examiner respectfully disagrees with the applicants because Walker teaches the processor receives the data from (**Col. 2, lines 51-53, which teaches "processor receives data identifying a first product code**) and it fails to disclose the memory stores the first product (**Col. 2, lines 43-45, which teaches a processor and a memory connected and memory stores a plurality of product codes**).

Applicant argued in page 14 that Walker fails to disclose "wherein the database server credits an account of a user associated with the given user station with a non-zero valuation credit only if such new candidate code received from the given user

station was not previously stored in the database.” However, the Examiner respectfully disagrees with the applicant for the following reasons:

a) Walker teaches the database server credits an account of a user associated with the given user station with non-zero valuation credit only if such new candidate code received from the given user station was not previously stored in the database *(Col. 2, lines 53-59, which teaches a processor (database server) determine initial credit value when receives data identifying a first product code and reduce the initial credit value by the product price and provide an adjusted credit value, which reads on credit non-zero valuation credit when received data identifying code (candidate code))*

b) **Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed**, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, the following optional claim language in claims 1, 25, 44, 50, 59 and 60 was not given patentable weight:

” if such new candidate code received from the given user station was not previously stored in the database”

While the Examiner addresses the optional limitation in this action, it is the Examiner’s opinion that these limitations do not distinguish the claim from the prior art. See MPEP 2106 II C (Paragraph 4+).

Applicant in pages 15 and 16 argued that the Examiner has failed to provide a specific basis for the rejection of claim 61 and claim 61 recites distinct elements for the other independent claims. Applicant emphasizes that the following limitation ”wherein said

at least one product is transacted in exchange for multiple resource type included in said account," has not been addressed since the element is distinct from the rest of independent claims.

However, the examiner respectfully disagrees with the applicant because the Examiner interpreted the above limitation as "wherein said at least one product is transacted (where "new candidate code received from a given user station" reads on at least on product is transacted) in exchange for multiple resource type included in said account, (where "receiving data ones of the uniquely identifying codes from user station, crediting non-zero promotional credit" reads on in exchange for multiple resource). Therefore, the above limitation addressed by Walker in **(Col. 2, lines 53-59, which teaches a processor (database server) determine initial credit value when receives data identifying a first product code and reduce the initial credit value by the product price and provide an adjusted credit value, which reads on credit non-zero valuation credit when received data identifying code (candidate code))**

Applicant augured in page 17 that a code reader at the user station is not old and well known at the time of filing of the application. However, the Examiner respectfully disagrees with the applicant because **(e.g. see in Schuessler et al. Patent No. 6,332,575, filed on Oct 30, 1998, Col. 1, lines 17-27, which teaches Optical systems for reading optical code symbols such as bar code, matrix code at the point of sale, Where "point of sale (POS)" reads on user station for looking up price and Col. 7, lines 40-57, computing device equipped with optical code reader be used as the heart of**

small stand alone cash register and number of code readers connect to a host terminal fixed or handheld code reader for inventory-control).

Applicant argued in pages 17 and 18 that the Examiner has to provide documentary evidence the Official Notice taken over" user is a retailer". However, the Examiner respectfully disagrees with applicant because , applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. Applicant could, for example, have gone on record with the alleged earliest date at which matrix based hierarchical navigation became common in interactive television. The examiner would than have been compelled to produce earlier references in order to maintain the tasking of official notice. But applicant submitted no such evidence. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D./

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Examiner, Art Unit 3688